

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

009270-0306759

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

10/705,496

Filed

November 12, 2003

First Named Inventor

ISHIGAME et al.

Art Unit

2876

Examiner

D. ST. CYR

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 47641☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

 39328for _____
Signature

E. RICO HERNANDEZ

Typed or printed name

(703) 905-2088

Telephone number

October 5, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Attorney Docket: 009270-0306759
Client Reference: 50G30890-USA-BT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

Confirmation Number: 4772

ISHIGAME ET AL.

Application No.: 10/705,496

Group Art Unit: 2876

Filed: November 12, 2003

Examiner: ST. CYR, DANIEL

Title: AUTOMATIC TICKET CHECKING APPARATUS

October 5, 2005

ATTACHMENT SHEETS TO PRE-APPEAL BRIEF CONFERENCE REQUEST

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby request that a panel of examiners formally review the legal and factual basis of the rejections in the above-identified application prior to the filing of an appeal brief. Appellants assert that the outstanding rejections (now on appeal by virtue of the concurrently filed Notice of Appeal) are clearly improper based both upon errors in facts and the omission of essential elements required to establish a prima facie rejection (i.e., the prior art references fail to disclose, teach or suggest all the recited claim features).

APPEALED REJECTION

Appellants are appealing the rejection of claims 23-33 and 37 under 35 U.S.C. 103(a) as being unpatentable over Aubrey (U.S. Patent No. 4,798,942) in view of Cubic Transportation System ("Cubic"). Applicants note that though claim 36 is indicated to be rejected in the Office Action mailed April 5, 2005, that claim has been cancelled. The Advisory Action mailed on September 20, 2005 includes only a cover page and a single page of Form PTOL-303 which contains no substantive comments. Instead, box 13 is checked and "See Continuation Sheet" is in the comment section of item 13. Neither the image file wrapper nor the copy received by Applicants include any continuation sheet. Applicants also note that claim 36 remains indicated as being rejected.

ARGUMENTS FOR TRAVERSAL

The appealed rejections are improper because a *prima facie* case of obviousness has not been established as the relied upon references fail to disclose, teach or suggest all of the features recited in combination in the rejected claims. In particular, Cubic is not prior art to the present application. Furthermore, Cubic fails to teach the elements of the claimed invention for which the Examiner relies on it in an enabling way. Finally, Aubrey teaches away from the asserted combination.

The present application claims priority to a U.S. application filed on February 28, 2001 and claims priority to three Japanese Patent Applications filed in February and March of 2000. The date of Cubic on its face is February 6, 2003 and it references an act that did not take place until February 2001. Thus, there is evidence that Cubic was not published until after February 2001. On the other hand, the Examiner has cited no evidence whatsoever that Cubic was published prior to February 6, 2003. Because the date of publication has not been established to be more than one year prior to (or even prior to at all) Applicants' priority date, the Cubic reference is not prior art, nor can it be used in support of a rejection under §103(a). The Interview Summary dated July 5, 2005 merely notes this argument, but does not provide any refutation of Applicants' position. The partial Advisory Action available in the image file wrapper likewise does not appear to address this point. (For a more detailed discussion of the facts and law relating to the improper use of Cubic as prior art, please see, e.g., p. 3, final paragraph through p. 4, first full paragraph of Applicants' Request for Reconsideration filed July 28, 2005).

As pointed out at p. 4, final full paragraph of the request for reconsideration, Cubic fails to teach or suggest both the "third judging means" and the "means for prohibiting...", recited in claim 23. During the personal interview, the Examiner took the position that these items were inherent to the Cubic reference, however that interpretation is contrary to the law of inherency. Applicants respectfully submit that, "...in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art." (See, e.g., MPEP 2112 citing *Ex Parte Levy*, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). Cubic merely consists of press releases that describe the construction of smart card ticketing facilities. Cubic is, however, silent about any specific features of the smart card ticketing facilities, much less about the specific features disclosed in claim 23.

Applicants respectfully submit that there has been no response to the argument that Aubrey teaches away from the asserted combination. In particular, the final action dated states at ¶7 that "Applicants' arguments filed 12/16/04 regarding claims 23-33 and 27 have been fully considered but they are not persuasive (see examiner remarks)." The "Remarks" below do not include any reference to the argument regarding Aubrey teaching away from the claimed invention. (Applicants' arguments relating to teaching away may be found, e.g., at p. 5-6 of the request for reconsideration and at pp. 15-16 of the response filed December 16, 2004).

The remaining independent claims at issue (26, 33 and 37) contain recitations similar to those of claim 23 and are patentable for at least the same reasons as well as the additional recitations therein. The dependent claims at issue (24-25, and 27-32) are patentable for at least the same reasons as the independent claims from which they depend. (See, request for reconsideration at 6 and 7).


CONCLUSION

Therefore, it is respectfully requested that the panel return a decision concurring with Applicants' position and eliminating the need to file an appeal brief because there are clear legal and/or factual deficiencies in the appealed rejections. In particular, Cubic is not prior art to the present application, it fails to teach the elements of the claimed invention for which the Examiner relies on it in an enabling way, and Aubrey teaches away from the asserted combination. Thus, all currently rejected claims 23-35-73 are allowable.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

 39328
E. RICO HERNANDEZ
Reg. No. 47641
Tel. No. 703.905.2088
Fax No. 703.905.2500

ERH/RCP/smm
P.O. Box 10500
McLean, VA 22102
(703) 905-2000